

Appl. No. 10/600,774
Atty. Docket No. 9281
Amdt. dated August 30, 2006
Reply to Office Action of May 30, 2006
Customer No. 27752

REMARKS

Claim Status

Claims 1-17 and 19-20 are pending in the present application. No additional claims fee is believed to be due.

Claims 2, 3, 7, 8, 12-14, and 17-20 have been cancelled.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Claim Objections

Claim 14 is objected to because the phrase "the topsheet" lacks antecedent basis in Claim 1 from which it depends.

Claim 14 has been cancelled. Accordingly, Applicants respectfully submit the objection is moot.

Rejection Under 35 USC §112 Second Paragraph

Claims 2, 12 and 13 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter.

Claims 2, 12, and 13 have been cancelled in a good faith effort at putting the amended claims in a form for allowance. Applicants respectfully submit the 35 USC §112 rejection of Claims 2, 12, and 13 is moot.

**Rejection Under 35 U.S.C. §103(a) Over Weisman et al. (US Patent No. 4,865,596) in
view of Bhambra (U.S. Patent No. 6,786,155)**

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Claims 1, 2, 4-6, 8, 12-14, 17 and 20 have been rejected under 35 U.S.C. §103(a) as obvious over Weisman et al. (U.S. Patent No. 4,865,596) in view of Bhambra (U.S. Patent No. 6,786,155).

Claims 2, 3, 7, 8, 12-14, and 17-20 have been cancelled in a good faith effort at putting the amended claims in a form for allowance.

The instant rejection of claims 1 and 4-6 under 35 U.S.C. §103 must comport with the standard set forth in *Graham v. John Deere Company* 383 US1, 148 USPQ 459 (1966), explained in MPEP Section 706. Moreover, MPEP Section 2143 outlines the Supreme Court's guidance in that landmark case, and requires that, to establish a *prima facie* case of obviousness, the USPTO must not only identify each claim element in the cited reference, but must also set forth some suggestion or motivation to modify the reference. Therefore, the Office Action must:

- (1) Set forth the differences in the claims over the applied references;
- (2) Set forth the proposed modification of the references which would be necessary to arrive at the claimed subject matter; and
- (3) Explain why the proposed modification would be obvious.

To satisfy Step (3), the Patent Office must identify where the prior art provides a motivating suggestion to make the modification proposed in Step (2). See *In re Jones*, 958 F2d 347, 21USPQ 2d 1941(Fed. Cir. 1992). The mere fact that the prior art may be modified as suggested by the Patent Office does not make the modification obvious unless the prior art suggests the desirability of the modification. See *In re Fritch*, 922 F2d 1260, 23 USPQ 2d 1780 (Fed. Cir. 1992).

Applicants show below that the current Office Actions failed to establish a *prima facie* case of obviousness by failing on at least one of points 1-3 in the Supreme Court's *Graham* requirements shown above.

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Accordingly, the arguments below will address each claim in light of the Supreme Court's *Graham* requirements.

I. The Office Action fails to make a *prima facie* case of obviousness for Claim 1

1. With respect to the first of the *Graham* factors, the Office Action fails to state where in Weisman et al. is disclosed the following claimed elements:

- a. a fluid permeable facing layer [of the absorbent article, as disclosed in the instant application] having a first elastic modulus. (The "facing layer 61" identified by the Office Action is not a facing layer as disclosed in the instant invention.);
- b. an absorbent core joined to the facing layer ... at substantially the entirety of their respective interfacial surfaces. (The "absorbent core 65" identified by the Office Action is not joined to any facing layer; note that a "topsheet" is shown as optional for the embodiment of FIG. 5 identified by the Office Action, and the topsheet so disclosed does not meet this limitation.);
- c. a fluid impermeable backsheet joined to the facing layer. (The "outer layer 60" identified by the Office Action is not disclosed as being fluid impermeable.); and
- d. wherein at equal strain from about 1% to about 5% the first elastic modulus [of facing layer] is greater than the second elastic modulus [of absorbent core];

2. As can be seen in the list above, the Office Action is clearly mistaken in identifying only one of these elements as missing, i.e., first modulus for the ling layer 61..

3. Bhambra fails to remedy the deficiencies of Weisman in failing to teach, disclose, or otherwise suggest all the limitations of Claim 1 missing in Weisman.

5. Therefore, as an initial matter, it is absolutely impossible to make out a *prima facie* case of obviousness in accordance with MPEP 2143 because the references

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fail to teach or suggest all of the claim limitations. The teaching or suggestion must be found in the prior art, not in the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicants submit that there can be no possible motivation to combine non-existent claim elements to achieve the claimed invention.

7. The Office Action provides no explanation as to why the necessary modifications would be obvious. In particular, the Office Action provides no reason why the person skilled in the art of making absorbent articles would have the slightest inclination to use the article of Bhambra, which relates to "printing forms, electronic parts and masks" (Field of the Invention). There is absolutely no nexus between the two references, and there is reason to believe any combination between the two would result in any successful article, much less the claimed invention. The combination is purely arbitrary, based on impermissible hindsight.

8. Because the Office Action failed to set out the differences between the claimed invention and the prior art, as shown above, and because the indicated claimed elements are not disclosed or suggested in the cited references, and because there is no (possible) suggestion or motivation to combine the (non-existent) elements of two references having no nexus to achieve the claimed invention, and because the Office Action provides no explanation as to why the necessary modifications based on two unrelated and unrelatable references would be obvious, Applicants respectfully submit that the Office Action has failed to make out a prima facie case of obviousness under 35 USC 103(a).

9. Accordingly, Applicants respectfully request that the rejection of Claim 1 be withdrawn. Likewise, the Applicants respectfully request that the rejection of Claims 4-6, which depend from Claim 1, also be withdrawn.

Rejection Under 35 U.S.C. §103(a) Over Weisman et al. (US Patent No. 4,865,596) in view of Bhambra (U.S. Patent No. 6,786,155) and further in view of Hammons (U.S. 2003/0004484)

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Claim 3 has been rejected under 35 U.S.C. §103(a) as obvious over Weisman et al. (U.S. Patent No. 4,865,596) in view of Bhambra (U.S. Patent No. 6,786,155) and further in view of Hammons (U.S. 2003/0004484).

Claim 3 has been cancelled in a good faith effort at putting the amended claims in a form for allowance. Applicants respectfully submit the 35 USC §103(a) rejection of Claim 3 is moot.

Rejection Under 35 U.S.C. §103(a) Over Weisman et al. (US Patent No. 4,865,596) in view of Bhambra (U.S. Patent No. 6,786,155) and further in view of Mackey et al. (U.S. Patent No. 4,986,882)

Claim 5 has been rejected under 35 U.S.C. §103(a) as obvious over Weisman et al. (U.S. Patent No. 4,865,596) in view of Bhambra (U.S. Patent No. 6,786,155) and further in view of Mackey et al. (U.S. Patent No. 4,986,882).

For the reasons given above with respect to Claim 1, Applicants respectfully submit that Claim 5 is allowable over the cited references. The addition of Mackey to make a three-way obviousness rejection adds nothing to remedy the deficiencies of Weisman and Bhambra alone.

Accordingly, Applicants respectfully request that the rejection of Claim 5 be withdrawn.

Rejection Under 35 U.S.C. §103(a) Over Weisman et al. (US Patent No. 4,865,596) in view of Bhambra (U.S. Patent No. 6,786,155) and further in view of Cinelli et al. (U.S. 2002/0013565)

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Claims 9-11 and 19 have been rejected under 35 U.S.C. §103(a) as obvious over Weisman et al. (U.S. Patent No. 4,865,596) in view of Bhambra (U.S. Patent No. 6,786,155) and further in view of Cinelli et al. (U.S. 2002/0013565).

Claim 19 has been cancelled in a good faith effort at putting the amended claims in a form for allowance. Applicants respectfully submit the 35 USC §103(a) rejection of Claim 19 is moot.

For the reasons given above with respect to Claim 1, Applicants respectfully submit that Claims 9-11 are allowable over the cited references. The addition of Cinelli for any purported disclosure of a secondary topsheet to make a three-way obviousness rejection adds nothing to remedy the deficiencies of Weisman and Bhambra alone.

Accordingly, Applicants respectfully request that the rejection of Claims 9-11 be withdrawn.

**Rejection Under 35 U.S.C. §103(a) Over Weisman et al. (US Patent No. 4,865,596) in
view of Bhambra (U.S. Patent No. 6,786,155) and further in view of Ohashi et al.
(2002/0065498)**

Claims 15 and 20 have been rejected under 35 U.S.C. §103(a) as obvious over Weisman et al. (U.S. Patent No. 4,865,596) in view of Bhambra (U.S. Patent No. 6,786,155) and further in view of Ohashi et al. (2002/0065498).

Claim 20 has been cancelled in a good faith effort at putting the amended claims in a form for allowance. Applicants respectfully submit the 35 USC §103(a) rejection of Claim 20 is moot.

For the reasons given above with respect to Claim 1, Applicants respectfully submit that Claim 15 is allowable over the cited references. The addition of Ohashi for any purported disclosure of a pair of "grooves 15" to make a three-way obviousness rejection adds nothing to remedy the deficiencies of Weisman and Bhambra alone.

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Accordingly, Applicants respectfully request that the rejection of Claim 15 be withdrawn.

Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejections. Early and favorable action in the case is respectfully requested.

This response represents an earnest effort to place the application in proper form and to distinguish the invention as now claimed from the applied references. Claims 2, 3, 7, 8, 12-14, and 17-20 have been cancelled in a good faith effort at putting the amended claims in a form for allowance. In view of the foregoing, reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1, 4-6, 9-11, 15 and 16 is respectfully requested.

Respectfully submitted,

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By


Signature

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